

Application No. 09/987,469
Amendment dated February 19, 2008
Reply to Office Action of November 16, 2007

Docket No.: 0020-4925P

REMARKS**Status of the Application**

Applicants note that the outstanding Office Action is indicated as non-final in the Office Action Summary. However the Office Action is then stated to be Final at page 3. Applicants note that this is the first action after the filing of an RCE. Applicants also note that the Declaration by Toshiyuki TARAO filed with the Reply dated May 29, 2007 has not yet been substantively responded to by the Examiner. Applicants here re-present the TARAO Declaration and associated arguments. Applicants accordingly understand the present action to be non-final. Clarification is requested.

Claims 1 and 4-9 are pending in the application. Claim 1 is currently amended. Reconsideration and allowance of all of the pending claims is respectfully requested.

New matter is not being added to the application as filed. The amendment to claim 1 only deletes the recitation of the nonionic cycloaliphatic diisocyanate base resin is present in an amount greater than 60% by weight. This limitation was not present in original claim 1 as filed and its removal is not new matter. Accordingly, entry of this amendment is respectfully requested.

Claim Rejections - 35 U.S.C. §103

Claims 1 and 4-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ichikawa '325 (U.S. Patent No. 6,582,325). Applicants respectfully traverse this rejection for the following reasons.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03. Applicants submit that the prior

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art does not disclose the polyurethane-based thermoplastic elastomer formed by using nonionic cycloaliphatic diisocyanate in the backbone structure recited in claim 1. Accordingly, it is respectfully submitted that claims 1 and 4-9 are presently allowable over the prior art and that this rejection must be withdrawn.

1. Backbone structure of the polyurethane molecule

Claim 1 expressly recites that the dicyclohexylmethane-4,4"-diisocyanate is contained in the backbone structure of the polyurethane molecule. Claim 1 thus clearly distinguishes Ichikawa '325. In Ichikawa '325, the diisocyanate is present in the side chains and not in the backbone of the polymer.

This was also shown by **Exhibit 1**, filed with the reply dated May 29, 2007. Exhibit 1 is also again attached to this amendment for the Examiner's convenience. Exhibit 1 clearly shows that Ichikawa '325 discloses urethane molecules which do not contain alicyclic diisocyanate, but are modified or crosslinked by the alicyclic diisocyanate. Applicants respectfully maintain that Ichikawa '325 therefore uses a different material. The cover resin of Ichikawa '325 is a reaction product of a thermoplastic polyurethane elastomer with dicyclohexylmethane-4,4"-diisocyanate (see, e.g., claim 1 of Ichikawa '325). In contrast, the present invention does not use this reaction product. Accordingly, all of the limitations of claim 1 are not disclosed or suggested by Ichikawa '325 and the Examiner has not established a *prima facie* case of obviousness of the present claims.

However, even assuming arguendo that the Examiner has established a *prima facie* case of obviousness of the present invention, applicants submit that the present invention exhibits unexpected results over the prior art. This was demonstrated by the declaration by Toshiyuki TARAO submitted with the Reply dated May 29, 2007 and is also attached to this amendment

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for the Examiner's convenience. The declaration demonstrates that the presently claimed golf ball exhibits unexpected results over the prior art. The Ichikawa '325 cover shows poor scuff resistance in comparison with the presently claimed golf ball cover. Accordingly, applicants submit that the patentability of the present claims is demonstrated, and that the pending prior art rejection should be withdrawn.

CONCLUSION

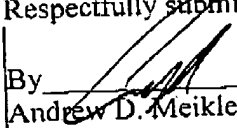
In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Konieczny, Reg. No. 47,715, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: February 19, 2008

Respectfully submitted,

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Attachment(s): Exhibit 1 and Declaration